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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/932,353	08/17/2001	Herbert Bachler	33891	4874
116	7590	10/21/2003	EXAMINER	
PEARNE & GORDON LLP 1801 EAST 9TH STREET SUITE 1200 CLEVELAND, OH 44114-3108			FOREMAN, JONATHAN M	
		ART UNIT		PAPER NUMBER
		3736		14

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/932,353

Applicant(s)

BACHLER ET AL.

Examiner

Jonathan ML Foreman

Art Unit

3736

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --***Period for Reply****A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.**

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 01 August 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 13-19 and 21-44 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 13-19 and 21-44 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s). _____.

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . 6) Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 34 and 35 are objected to under 37 CFR 1.75(c), as being of improper form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper form. The limitations set forth in claims 34 and 35 were previously set forth in claim 30.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 13 – 19, 21 – 26, 28 – 31, 33 – 38, 40 – 42 and 44 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,800,336 to Ball et al.

In reference to claims 13 – 19, 21 – 26, 28 – 31, 33 – 38, 40 – 42 and 44, Ball et al. discloses at least one permanent magnet (42) adapted for being solidly or removably attached on a promontory in the area of the middle ear (Col. 25, lines 42 – 45); and at least one coil (14) for being placed in the middle ear behind the tympanic membrane, an area of an ossicle chain or at the tympanic membrane. The magnet is radially polarized and is circular in shape (Col. 10, lines 36 – 50). The coil disclosed by Ball et al. is considered by the examiner to extend in a plain parallel, perpendicular, and between 0 and 180 relative to the magnet in that the relative axis defined can be any surface of the magnet. Ball et al. discloses converting an acoustic signal into an electrical signal (Col. 9, lines 16 – 18); and converting the electrical signal into a mechanical oscillation of a coil (14)

in a middle ear by utilizing a permanent magnet (42) solidly or removably attached on a promontory (Col. 9, lines 17 – 29; Col. 25, lines 42 – 45).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 27, 32, 39 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,800,336 to Ball et al. as applied to the claims above.

In reference to claims 27, 32, 39 and 43, Ball et al. discloses converting an acoustic signal into an electrical signal (Col. 9, lines 16 – 18); and converting the electrical signal into a mechanical oscillation of a coil (14) in a middle ear by utilizing a permanent magnet (42) solidly attached on a promontory (Col. 9, lines 17 – 29; Col. 25, lines 42 – 45). Additionally, Ball et al. discloses an air-gap between a permanent magnet and a coil, but does not disclose the air-gap being adjustable.

However, adjustability, where desirable, is a modification that is within the skill of the art. *In re Stevens*, 212 F.2d 197, 101 USPQ 284 (CCPA 1954). In the present case it would be desirable, and thus an obvious modification to one having ordinary skill in the art at the time the invention was made, to adjust the air-gap between the magnet and the coil in order to increase or reduce the intensity of the mechanical oscillation of the coil.

Response to Arguments

6. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. DE 41 04 358 A1 to Implex GmbH for its disclosure of an electromechanical transducer mounted on the promontory, and U.S. Patent Application Publication No. 2001/0055405 to Cho for its disclosure related to both a magnet and coil positioned within the middle ear.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (703)-305-5390. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max F Hindenburg can be reached on (703)308-3130. The fax phone numbers for the organization where this application or proceeding is assigned are (703)-308-0758 for regular communications and (703)-308-0758 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)-308-0858.

JMLF
October 19, 2003

Max Hindenburg
MAX F. HINDENBURG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700